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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,830	02/09/2004	Marilyn Sadallah	MS-1-gw	9789

7590

06/28/2005

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Syosset, NY 11791

EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,830

Applicant(s)

SADALLAH, MARILYN

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Species I. Figure 4;

Species II. Figure 5;

Species III. Figures 6-12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Michael I. Kroll on June 22, 2005 a provisional election was made with traverse to prosecute the invention of Species III (figures 6-12), claims 10-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The abstract of the disclosure is objected to because it contains more than 150 words which is improper. On line 3, legal phraseology "means" is used which is improper. On line 9 the word "invention" is used which is improper. Correction is required. See MPEP § 608.01(b).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: stating in claim 11 the system includes a "top cap ring", the specification uses the term "top cap".

Claim Objections

Claims 10-14 are objected to because of the following informalities: In claim 10, line 5, "the said bottom" should be "said bottom end" since there is no antecedent basis for "the said bottom". In claim 10, line 6, "said top" should be "said top end" since there is no antecedent basis for "said top". In claim 11, line 2, "said top" should be "said top end". Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, lines 5-6, the phrase “to form a U-shaped sleeve” is considered to be misdescriptive since the cross-section of the sleeve is U-shaped by not the overall shape of the sleeve as suggested in this phrase.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama (U.S. Patent No. 4,928,412) in view of Campbell (U.S. Patent No. 4,570,454).

The examiner has taken the position that the applicant is positively claiming the trash receptacle in combination with the sleeve and placard. Nishiyama shows in figures 1-4 a “trash receptacle” (24), a protective sleeve (10) having inner (14) and outer walls (12) attached at the bottom and forming a U-shaped sleeve, the sleeve including an aperture (18) for receiving a handle, a placard (31) having a decorative image (46) thereon. Nishiyama does not disclose placing an aperture within the placard. Campbell shows in figure 10 a display type device that includes apertures therein. In view of the teachings of Campbell it would have been obvious to one in the art to modify Nishiyama by placing an aperture in the card since this would create a

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more amusing and aesthetically pleasing display. The apertures in the placard could receive the handle before it is assembled. Positively defining the handle on the trash receptacle and positively defining that the handle passes through the aperture in the sleeve and placard would appear to read over the Nishiyama patent. In regard to claims 11 and 12, Nishiyama shows in figure 1 a U-shaped ring (32). In regard to claim 14, the inner and outer walls (10,12) of the sleeve are transparent/clear.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama (U.S. Patent No. 4,928,412) in view of Campbell (U.S. Patent No. 4,570,454) as applied to claim 12 above, and further in view of Zilberman (U.S. Patent No. 6,905,043).

Nishiyama in view of Campbell disclose the applicant's basic inventive concept except for attaching a gasket between the ring and sleeve. Zilberman shows in figures 1 and 4 the idea of attaching a gasket (40) between a ring member and wall member. In view of the teachings of Zilberman it would have been obvious to one in the art to modify Nishiyama by attaching a gasket between the ring and sleeve since this would create a better seal and reduce the likelihood of leakage.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Richardson et al., Richardson, Swerdloff, and Dunn teach the use of trash receptacles that include indicia thereon.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
June 24, 2005